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In re Application of :
HOULBERG *et al* :
U.S. Application No.: 10/586,325 :
PCT No.: PCT/DK2005/00027 :
Int. Filing Date: 17 January 2005 :
Priority Date: 16 January 2004 :
Attorney Docket No.: 58982.000040 :
For: METHOD AND SYSTEM FOR :
COLORIMETRIC DETERMINATION OF :
A CHEMICAL OR PHYSICAL :
PROPERTY OF A TURBID :

DECISION

This decision is in response to the "Request for Reconsideration of Petition Decision" submitted on 21 April 2008.

BACKGROUND

On 19 February 2008, a decision dismissing applicants' 37 CFR 1.47(a) petition was mailed. Applicants were given two months to respond.

On 21 April 2008, applicants filed a renewed petition under 37 CFR 1.47(a) which contained, *inter alia*, a copy of a letter dated 26 March 2008 and a postal receipt.

DISCUSSION

As noted in the original decision, applicants' petition under 37 CFR 1.47(a) was dismissed for failing to show that a complete copy of the application including specification, claims and drawings were presented to the nonsigning inventor. As such, no refusal could be shown. All other items of 37 CFR 1.47(a) were completed.

In the renewed petition, applicants have provided a copy of a cover letter sent to the nonsigning inventor dated 26 March 2008. Applicants also included a copy of the confirmation provided by the international courier service.

A review of the cover letter indicates that a complete copy of the subject application was included in the documents sent to Mr. Sturino. In a telephone call with the U.S. counsel on 12 June 2008, Ms. Robin Teskin verifies that no response to this

letter has been received by the 37 CFR 1.47 applicants.

Nonetheless, the requirements of section 409.03(d) of the MPEP regarding a refusal are still not met. For a refusal to join to be accepted, the 37 CFR 1.47(a) applicants must present the nonsigning inventor with a complete copy of the application along with the documents to sign such as a declaration. See *In re Gray*, 115 USPQ 80 (Comm'r Pat 1956).

In this case, the 26 March 2008 letter to Mr. Sturino requests his opinion which group of claims (I, II or III) to elect in the subject patent application. The letter does not request that Mr. Sturino join in the above-captioned application by signing an oath or declaration. As such, there is no refusal to contemplate.

It is noted that in a telephone call initiated by the undersigned on 12 June 2008, counsel argues that the nonsigning inventor was previously given a declaration to sign and did not respond. All that was required was to provide the nonsigning inventor with a copy of the application. That is not the case. As noted in the prior decision:

This conduct would be sufficient to show a refusal to cooperate pursuant to section 409.03(d) of the MPEP if the nonsigning inventor was presented with a complete copy of the subject application also.

But Mr. Sturino was not presented with a complete copy of the application. Accordingly, the prior conduct of Mr. Sturino is irrelevant.

In this case, the 37 CFR 1.47(a) applicants have provided the nonsigning inventor with a complete copy copy of the subject application. Petitioners must now request that Mr. Sturino cooperate in the above-captioned application. A failure to respond by the nonsigning inventor may be considered conduct that constitutes a refusal to cooperate. See § 409.03(d) MPEP.

Item (2) of 37 CFR 1.47(a) is still not satisfied.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter may be filed electronically

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via the USPTO EFS-Web, by facsimile to (571) 273-0459, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450.

A handwritten signature in cursive script, appearing to read "James Thomson", written in black ink.

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